

REMARKS

The Examiner has required restriction under 35 U.S.C. §121 and §372 between the following:

1. Group I, claim(s) 39, 40, 42, 46, 55, 61 and 72;
2. Group II, claim(s) 39, 41, 43, 44 and 47;
3. Group III, claim(s) 39, 45, 48-53 and 87-91;
4. Group IV, claim(s) 39, 54 and 56-59;
5. Group V, claim(s) 39, 60, 62, 66 and 68-70;
6. Group VI, claim(s) 39, 63 and 64;
7. Group VII, claim(s) 39, 65 and 67;
8. Group VIII, claim(s) 39 and 71;
9. Group IX, claim(s) 73-85;
10. Group X, claim(s) 86 and 92; and
11. Group XI, claim(s) 93 and 94-99.

Respectfully, Applicant traverses this restriction requirement. Relying on MPEP §1850, the Examiner states that “since independent claim 39 does not avoid the prior art” based on Schuster (US patent no. 6,417,914), “lack of unity is proper[.]” (page 5 of paper no. 20090812).

Independent claim 39 recites

... a mount that is connected, on the one hand, to the objective and, on the other hand, at least indirectly to the optical element, there being *arranged between the mount and the optical element* **a reinforcing element** whose coefficient of thermal expansion corresponds substantially to the coefficient of thermal expansion of the optical element.

Accordingly, independent claim 39 recites to at least four different structures: 1) a mount; 2) an objective; 3) an optical element; and 4) a reinforcing element. Schuster teaches three structures in Fig. 6 on which

the Examiner relies for teaching independent claim 39: a mount, an objective and an optical element. Schuster does not teach four structures missing the positively recited *reinforcing element* of claim 39. Schuster teaches “the last lens of the objective 10 is of bipartite construction with an inner part and an outer part, the essentially thinner outer part being connected with the inner part of the lens in a mount-free fashion” (col. 3, lines 65-67 and col. 4, lines 1-3). In direct contradiction to Schuster’s teaching that the last lens is a lens (yet in a “severed” bipartite construction (col. 3, lines 65-67)), the Examiner relies on this teaching to suggest that the bipartite lens teaches two positively recited structures of independent claim 39, the optical element and *reinforcing element*. In no fair or reasonable interpretation does two portions of a lens teach or suggest two different positively recited structures. The lens of Schuster is just that, a lens, a single structure, not two structures.


Moreover, in no fair or reasonable interpretation does a portion of a lens teach a reinforcing element. That is, no valid argument can be made that a portion of the last lens of Schuster can be characterized as a reinforcing element. In conclusion, the last lens of Schuster, even though severed into two portions, only teaches three structures and does not teach the four positively recited different structures of claim 39. Additionally, no fair or reasonable interpretation does a portion of a lens teach a reinforcing element. Accordingly, the Examiner has failed to demonstrate that independent claim 39 “does not avoid the prior art” pursuant to MPEP

§1850, and therefore, lack of unity for the pending claims of the present application has not been demonstrated. Logically, having not demonstrated a lack of unity, the restriction requirements are improper and should be withdrawn. Applicant respectfully requests withdrawal of the restriction requirements and prosecution on the merits for pending claims 39-99.

The Applicant elects Group I for prosecution on the merits which includes the invention as claimed by independent claim 39. Claims 40-86 and 92 encompasses the elected invention claimed by independent claim 39, and therefore, these claims are appropriate for prosecution on the merits.

Respectfully submitted,

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By: 
D. Brent Kenady
Reg. No. 40,045